

REMARKS

Claims 1-19 are presented for examination.

Claims 1-3, 6, 7, 9-15, 17 and 19 have been rejected under 35 U.S.C. 102(e) as being anticipated by Gafken. Dependent claims 4, 5, 16 and 18 have been rejected under 35 U.S.C. 103 as being unpatentable over Gafken in combination with Bowen et al.

These rejections are respectfully traversed for the following reasons. It is well settled that the Examiner bears the initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention under any statutory provision. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Anticipation under 35 U.S.C. § 102 requires the disclosure in a single reference of each element of a claimed invention. *Minnesota Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). In rejecting a claim under 35 U.S.C. § 102, it is incumbent upon the Examiner to point out specifically wherein an applied reference discloses each feature of the claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). It is respectfully submitted that the Examiner did not discharge that burden.

In particular, claim 1 recites a memory system for a portable telephone including a signal transmission/reception portion for transmitting and receiving a signal and a control portion for controlling at least a signal transmission and reception operation of said transmission/reception portion.

The memory system comprises:

- a random access memory providing a working area for said control portion; and

- a flash memory including a memory array for storing a program for said control portion and at least transmission and reception data in a non-volatile manner under a control of said control portion.

Claim 1 specifies that the memory array is divided into a plurality of storage units, and a register, provided commonly to the respective storage units, and having information in a storage unit of said plurality of storage units transmitted thereinto for temporal storage of the transmitted information and allowing serial readout of the transmitted and stored information.

Further, independent claim 12 also recites that the memory array is divided into a plurality of storage units. The claim specifies that a plurality of pieces of information in one unit of the storage units selected in accordance with an address signal at a time, are allowed to be serially read out in synchronization with a clock signal without further address application.

The Examiner has failed to point out specifically wherein Gafken discloses a register, provided commonly to the respective storage units, and having information in a storage unit of said plurality of storage units transmitted thereinto for temporal storage of the transmitted information and allowing serial readout of the transmitted and stored information, as claim 1 requires.

Instead the Examiner relies upon col. 3, lines 37-50, line 66 to col. 4, line 13, line 48 to col. 5, line 15, col. 9, lines 28-40 and FIG. 9).

For example, the Examiner has failed to identify which element in FIG. 9 is considered to correspond to the claimed register. It is noted that FIG. 9 does not show any registers.

Moreover, the Examiner has failed to address the limitation of claim 12 reciting that a plurality of pieces of information in one unit of the storage units selected in accordance with an

address signal at a time, are allowed to be serially read out in synchronization with a clock signal without further address application.

Considering the reference, Gafken discloses a cellular phone 900 including a flash memory 115 (FIG. 9). As shown in FIG. 1, the flash memory 115 includes a memory array 130 with memory blocks for storing data, and registers 137. As shown in FIG. 3, the registers 137 include operation register 301 and base address register 302.

As disclosed in col. 5, lines 35-40, the registers 137 may be used during a code update process, for example, to indicate the type of code update process to be performed, and the address at which the new code can be found. Also, the registers 137 may be used for passing messages through a reset event because they are not cleared by the reset event (col. 5, lines 42-45).

Therefore, the registers 137 do not correspond to the claimed register, provided commonly to the respective storage units, and having information in a storage unit of said plurality of storage units transmitted thereinto for temporal storage of the transmitted information and allowing serial readout of the transmitted and stored information, as claim 1 requires.

Moreover, the registers 137 are provided outside of the memory array 130.

Hence, Gafken does not disclose the claimed memory array divided into a plurality of storage units, and a register, provided commonly to the respective storage units, and having information in a storage unit of said plurality of storage units transmitted thereinto for temporal storage of the transmitted information and allowing serial readout of the transmitted and stored information, as claim 1 recites.

Also, Gafken does not disclose that a plurality of pieces of information in one unit of the storage units selected in accordance with an address signal at a time, are allowed to be serially

read out in synchronization with a clock signal without further address application, as independent claim 12 requires.

In the event the Examiner relied upon inherency without expressly indicating such reliance, the Examiner should be aware that inherency requires certainty, not speculation. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); *In re Oelrich*, 666 F.2d 578, 212 USPQ 323 (CCPA 1981); *In re Wilding*, 535 F.2d 631, 190 USPQ 59 (CCPA 1976). To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probability or possibilities. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

The Examiner provided no factual basis upon which to conclude that the registers 137 of Gafken necessarily have information in a storage unit of said plurality of storage units transmitted thereinto for temporal storage of the transmitted information and allowing serial readout of the transmitted and stored information, as claim 1 recites.

Moreover, one skilled in the art would realize that the registers 137 of Gafken are not involved in data communication with the memory blocks of memory array 130. Therefore, they cannot operate in the manner required by claim 1.

In addition, the Examiner provided no reason to conclude that the Gafken's arrangement necessarily operates in the manner required by claim 12.

Accordingly, Gafken neither expressly nor inherently discloses the arrangements recited in independent claims 1 and 12. Therefore, the reference does not describe the claimed invention

Application No.: 09/514,369

within the meaning of 35 U.S.C. § 102. *Minnesota Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc., supra.*

The dependent claims 2-11, and 13-19 are defined over the prior art at least for the reasons presented above in connection with the respective independent claims.

Hence, it is respectfully submit that the rejections of claims 1-19 are untenable and should be withdrawn.

In view of the foregoing, and in summary, claims 1-19 are considered to be in condition for allowance. Favorable reconsideration of this application is respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Alexander V. Yampolsky
Registration No. 36,324

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 AVY:apr
Facsimile: 202.756.8087
Date: November 6, 2006

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